REMARKS/ARGUMENTS

Claims 1-24 are pending. Claims 5, 15, and 21-24 are amended. Support for the claim amendments can be found in the claims as originally filed and in the specification on page 19, l. 23 through p. 20, l. 11. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 112, Second Paragraph: Asserted Indefiniteness

The examiner rejected claims 5, 15, and 21-23 under 35 U.S.C. § 112, second paragraph as indefinite due to the presence of the trademark "JAVA." Applicants have amended the claims to recite the trademarked term in the proper format under the standards of MPEP § 608.01(v) and MPEP § 2173.05(u).

Applicants also note that 1,705 issued patents contain the term "Java" in the claims, as of August 10, 2007. Furthermore, the search, "computer and aclm/java" on the USPTO search engine found 1,637 patents, meaning that the bulk of the patents found recite the Java programming language in the claims. Thus, one of ordinary skill would recognize what is being claimed in the instant invention and the term does not render the claims indefinite. Accordingly, this rejection is overcome.

II.   35 U.S.C. § 101: Asserted Non-Statutory Subject Matter

The examiner rejected claim 24 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Applicants have amended claim 24 accordingly, thereby overcoming the rejection.

III.   35 U.S.C. § 102: Asserted Anticipation

The examiner rejected claims 1, 11, and 24 under 35 U.S.C. § 102 as anticipated by *Ohta*, Algorithm Training System, U.S. Patent 5,697,788 (December 16, 1997) (hereinafter "*Ohta*"). This rejection is respectfully traversed. The examiner states that:

> Claim 1:
> - Ohta teaches a method for presenting a step of a task, wherein the task includes a series of steps to be performed, the method comprising: identifying a current
>
> - According to Ohta, "Fig 15 is an illustration showing the algorithm window of the present program while the program created by a selected programming language is being executed in a single-step manner" (see Drawing Description). The examiner notes that the left screen shows previous, current, and succeeding steps of a task. The right screen shows the details of the currently selected action

Office action of May 10, 2007, pp. 3-4.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1 is as follows:

> 1.   A method for presenting a step of a task, wherein the task includes a series of steps to be performed, the method comprising:
>> identifying a current step within the series of steps;
>> retrieving a step component for the current step; and
>> presenting the current step inline within the series of steps such that the step component is presented in context within the series of steps.

Ohta does not anticipate claim 1 because *Ohta* does not teach the claimed feature of, "retrieving a step component for the current step," or the claimed feature of, "presenting the current step inline within the series of steps such that the step component is presented in context within the series of steps." The examiner asserts otherwise, citing figure 15 of *Ohta*, which is reproduced below:

Fig. 15

101⌐   113
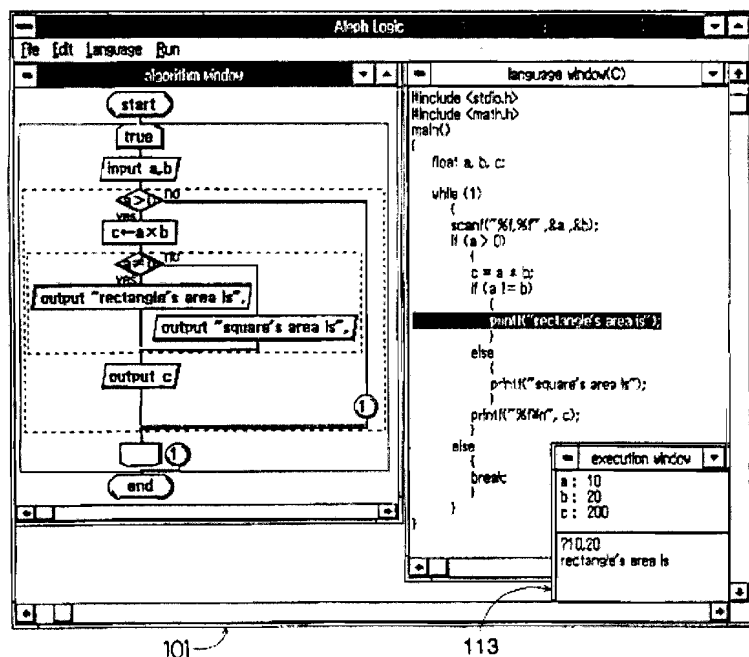
The examiner also cites the text associated with this figure. The text associated with figure 15 is as follows:

As one of the outstanding features of this embodiment, simply clicking the desired programming language in the language menu on the menu bar 105 of the algorithm window 101 will automatically create the source program in that language. And both the flow-chart and its source program are verifiable on the same screen. For example, if the C-language is selected, the

algorithm training program of the invention will execute the steps
S40b.about.S41 in sequence and show in the language window 114 the whole
text of the program created in that language for the flow-chart. At this point,. as
each of the instruction symbols 201 is executed one by one, a corresponding
portion in the text of the source program is covered with a mesh screen in order
to show the learner the progress of instruction execution (FIG. 15).

Ohta, col. 9, ll. 23-36.

Ohta teaches that by clicking on the desired programming language in the language menu (the upper right menu shown in the screenshot of figure 15), *Ohta*'s program will automatically create the source program in the language. Thus, for example, given the flow chart shown in the left-hand side window, *Ohta*'s system can create the C code shown in the right hand side of the window. As each of the instruction symbols is executed one by one, a corresponding portion in the text of the source program is covered with a mesh screen (the highlighted line in the right hand portion of the screenshot) to show the student the progress of instruction execution. Thus, a person learning how to program can see how code is generated in order to execute a flowchart.

The actual flowchart shown on the left hand side of the screenshot of figure 15 is created by a user or is retrieved from a data file. A user can also modify a retrieved flowchart. In any case, the flowchart is created and *Ohta*'s system will then construct code based on the flowchart.

Thus, in *Ohta*, the entire flowchart is constructed or known and then code is created based on the flowchart. In no case does *Ohta* actually teach "retrieving a step component for the current step," as required by claim 1. Instead, *Ohta* only teaches receiving entire steps in the flowchart, not retrieving sub-steps within the flowchart. Similarly, *Ohta* does not teach, "presenting the current step inline within the series of steps such that the step component is presented in context within the series of steps," as recited in claim 1. Instead, *Ohta* teaches only the entire series of steps without breaking down a sub-step inline within the series of steps.

Furthermore, even if any given step in the flowchart or code of *Ohta* were interpreted to be a sub-step, *Ohta* still would not anticipate claim 1. *Ohta* does not teach that a subcomponent is presented *in context within* the series of steps because *Ohta* does not recognize or teach substeps as being within steps. Therefore, again, *Ohta* does not teach the claimed feature of, "presenting the current step inline within the series of steps such that the step component is presented in context within the series of steps," as recited in claim 1. Accordingly, under the standards of *In re Bond*, *Ohta* does not anticipate claim 1.

Claims 11 and 24 contain features similar to those presented in claim 1. Therefore, for similar reasons, *Ohta* also does not anticipate claims 11 and 24. Accordingly, this rejection is overcome.

IV.   35 U.S.C. § 103: Asserted Obviousness

IV.A.   Claims 2-4 and 12-14

The examiner rejects claims 2-4 and 12-14 under 35 U.S.C. § 103 as obvious in view of *Ohta* and

Broulik et al., Web based GUI Server and Method for a Telecommunications Node, U.S. Patent 6,323,881

(November 27, 2001) (hereinafter *"Broulik"*). This rejection is respectfully traversed. Regarding claim 2,

the examiner states that:

> *Ohta* discloses **a method wherein identifying a current step within the series of steps includes receiving a request from a client.**
>
> - According to Ohta, "Fig 15 is an illustration showing the algorithm window of the present program while the program created by a selected programming language is being executed in a single-step manner" (see Drawing Description).
>
> - The examiner notes that the left screen shows previous, current, and succeeding steps of a task. The right screen shows the details of the currently selected action.
>
> Ohta does not appear to explicitly disclose receiving a request from a client. Broulik discloses receiving a request from a client.
>
> - According to Broulik, "in web terminology, the client is called a browser (col 3, lines 55-63);. ..and the HTTP server receives requests from browsers one at a time. The HTTP server is supported by common gateway interface (CGI) tasks (programs). Requests accepted by the server are passed to CGI tasks for execution/processing. The CGI tasks then return the results to the browsers" (col 3, line 64 - col4, line 7). Also, "a web based GUI works on the client-server paradigm.. . and are based on standard protocols TCP/IP and HTTP" (col 3, lines 50-55).
>
> - The examiner notes that in order for web page to function, the standard TCP/IP is used. The client makes a request to the server, the server processes the request, and the server sends a response to the client.
>
> Ohta and Broulik are analogous art because they are from the same field of endeavor of graphical user interface applications.
>
> At they time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Ohta and Broulik before him or her, to modify the GUI that identifies a current step within the series of steps to include communication with a client and server.
>
> The motivation for doing so would have been to allow a user interface with inline representation of steps in a multi-stepped process in conjunction with a network

or web based system in order to allow a user or multiple users to access the application.

Ohta and Broulik are analogous art because they are from the same field of endeavor of graphical user interface applications.

Office action of May 10, 2007, pp. 6-7 (emphasis in original).

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are… determined; differences between the prior art and the claims at issue are… ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Claim 2 is as follows:

> 2.   The method of claim 1, wherein identifying a current step within the series of steps includes receiving a request from a client.

IV.A.1. The Proposed Combination of References, Considered as a Whole, Does Not Teach or Suggest all of the Claimed Features

The examiner failed to state a *prima facie* obviousness rejection against claim 2 because the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1, from which claim 2 depends. As shown above, *Ohta* does not teach all of the features of claim 1. Furthermore, *Ohta* does not suggest the claimed feature because *Ohta* is devoid of disclosure regarding the features of claim 1. Additionally, *Ohta* does not suggest the features of claim 1 because *Ohta* is not concerned with identifying substeps within steps because *Ohta* is only concerned with showing all of the steps of a generated flowchart.

Additionally, *Broulik* does not teach or suggest all of the features of claim 1. *Broulik* teaches a web based graphical user interface server and method for a telecommunications node that provides craft

user interface capability with regard to remote login. *Broulik*, Abstract. *Broulik* is completely devoid of disclosure regarding the features of claim 1.

Therefore, neither *Ohta* nor *Broulik* teach or suggest all of the features of claim 1. Accordingly, the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1. Hence, under the standards of *In re Royka*, the examiner failed to state a *prima facie* obviousness rejection against claim 1.

At least by virtue of the dependency of claim 2 on claim 1, the examiner failed to state a *prima facie* obviousness rejection against claim 2. For similar reasons, the examiner failed to state a *prima facie* obviousness rejection against claims 3, 4, and 12-14.

IV.A.2. The Examiner Failed To State a Proper Reason To Combine the References Under the Standards of *KSR Int'l.*

Additionally, the examiner failed to state a *prima facie* obviousness rejection against claim 2 because the examiner failed to state a proper reason to combine the references under the standards of *KSR Int'l*. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Regarding a reason to combine the references, the examiner states that, "the motivation for doing so would have been to allow a user interface with inline representation of steps in a multi-stepped process in conjunction with a network or web based system in order to allow a user or multiple users to access the application." However, this reason is not a rational underpinning to support the legal conclusion of obviousness of claim 2 in view of the combination of the references when considered as a whole. As a first matter, as shown above, *Ohta* does not teach a user interface with inline representation of substeps in a multi-stepped process. As a second matter, *Broulik* is directed towards remote login though telecommunications systems via a graphical user interface, not displaying steps within a process. As a third matter, access to an application is irrelevant to the invention of claim 2. Instead, the invention of claim 2 leaves the matter of access silent and is only concerned with how to present the steps of the process.

Whether access is granted and to how many users access is granted is irrelevant to the invention of claim 2. Therefore, the examiner's statement does not provide a rational underpinning to support the legal conclusion of obviousness, as required by *KSR Int'l*. Accordingly, under standards of *KSR Int'l.*, the examiner failed to state a *prima facie* obviousness rejection against claim 2.

IV.A.3. No Reason Exists To Combine the References Under the Standards of *KSR Int'l*.

Additionally, no rational reason exists to combine the references to achieve the invention of claim 2 when the references are considered as a whole. *Ohta* is directed to the creation of code from a flowchart. *Broulik* is directed to remote login systems via a graphical user interface. The two references have nothing to do with each other, other than both references require the use of a computer to perform the disclosed methods.

Because the references have nothing to do with each other, one of ordinary skill could find no reason to combine the references to achieve the invention of claim 2, when the references are considered together as a whole. Accordingly, under the standards of *KSR Int'l.*, the examiner failed to state a *prima facie* obviousness rejection against claim 2.

IV.A.4. *Broulik* Is Non-Analogous Art.

The examiner has failed to state a *prima facie* obviousness rejection because *Broulik* is non-analogous art. In order to rely on a reference as a basis for rejection, the reference must be either in the applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986).

In the case at hand, *Broulik* is not in the same field of endeavor as claim 2, and *Broulik* is not reasonably pertinent to the particular problem with which Applicants were concerned. With regard to the first part of the test for analogous art, *Broulik* is not in the same field of endeavor as claim 2 because *Broulik* is in the field of login methods for telecommunications systems. In contrast, claim 2 is in the field of presenting methods to users. The two fields are completely distinct from each other because the methods and techniques taught by the two references are completely distinct from each other. Thus, *Broulik* fails the first test of *In re Oetiker*.

With regard to the second part of the test for analogous art, *Broulik* is not reasonably pertinent to the particular problem with which Applicants were concerned. As established above, *Broulik* is in the field of login methods for telecommunications systems. Specifically, *Broulik* is directed to the problem of remote login via graphical user interfaces. For example, *Broulik* provides that:

> A further problem is GUI clients do not support remote logins. The ability to connect (to login) to another node, thereby performing a remote login, is a basic requirement of the craft user interface (CUI). With the GUI client-server paradigm, this requirement is very difficult to satisfy. Theoretically it is possible to develop proprietary protocols (or use the old TL-1 protocol), but in practice such solutions would be very expensive and very difficult to maintain. This

would mean that GUI clients would have to be able to interpret commands of all products, leading to very large GUI clients with nearly impossible version control requirements (i.e. they would have to be in sync with many products).

Broulik, col. 2, ll. 21-41.

In contrast, claim 2 is directed to the problem of presenting methods to users. The problem addressed by *Broulik* is completely distinct from the problem addressed by claim 2. For this reason, *Broulik* is not reasonably pertinent to the particular problem with which Applicants were concerned. Therefore, *Broulik* fails the second part of the *In re Oetiker* test for analogous art.

Nevertheless, the examiner states that:

> Ohta and Broulik are analogous art because they are from the same field of endeavor of graphical user interface applications

Office action of May 10, 2007, p.8

The examiner appears to confuse the concept of non-analogous art. The question is not whether *Ohta* and *Broulik* are analogous to each other, but rather whether *Ohta* and *Broulik* are analogous *to claim 2*. As shown below, *Broulik* is not analogous to claim 2.

In light of the requirements of *In re Oetiker*, the examiner's characterizations of *Broulik* and claim 2 are too broad to establish that *Broulik* is in the same field of endeavor as claim 2. For example, the court in *In re Oetiker* stated that:

> The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art.

In re Oetiker, 977 F.2d 1443 at 1446.

The examiner in *In re Oetiker* attempted to use substantially the same argument as the present examiner. The argument is as follows: Because the reference and the claim both deal with the same broad class of problem, the reference is in the same field of endeavor as the claimed invention. However, the Court of Appeal for the Federal Circuit specifically states that this argument is incorrect:

> *It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.* The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of *Hind*sight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

Id. at 1447 (emphasis supplied).

The court ruled that the examiner failed to show that a person of ordinary skill solving a problem of fastening *hose clamps* would reasonably be expected or motivated to look to a reference dealing with *fasteners for garments*. Even though both technologies are in the same broad field of fastening objects, the reference was still considered to be non-analogous art.

In the case at hand, *Broulik* is directed to the field of login methods for telecommunications systems. In contrast, claim 2 is directed to the field of presenting methods to users. These fields are more distinct from each other than the field of hose clamps and the field of fasteners for garments. In fact, the fields of hose clamps and fasteners for garments are *more* closely related because both are fasteners. In stark contrast, the invention of claim 2 is more divergent from the field of *Broulik*. Therefore, under the standards of *In re Oetiker*, *Broulik* is non-analogous art to claim 2, notwithstanding the examiner's assertions to the contrary. Accordingly, the examiner failed to state a *prima facie* obviousness rejection against claim 2.

The rejections of claims 3, 4, and 12-14 all rely on the combination of *Ohta* and *Broulik*. Therefore, because *Broulik* is non-analogous art, the examiner also failed to state a *prima facie* obviousness rejection against these claim. Accordingly, this rejection is overcome.

IV.B.   Claims 5, 6, 8-10, 15, 16, 18-21, and 23

The examiner rejects claims 5, 6, 8-10, 15-16, 18-21, and 23 under 35 U.S.C. § 103 as obvious in view of *Ohta, Broulik,* and *Hind*, Achieving Application-Specific Document Content by Transcoding Using Java Server Pages, U.S. Patent 6,715,129 (March 30, 2004) (hereinafter "*Hind*"). This rejection is respectfully traversed. With respect to claim 5, the examiner states that:

> Ohta discloses **a method presenting current step inline with a series of steps** (Fig.1 5).
>
> Broulik discloses **Java**.
>
> - According to Broulik, "in web terminology, the client is called a browser. The browser is a platform independent GUI engine that accepts and interprets standard data formatting descriptions (HTML), standard script language constructs (JavaScript) and standard Java written small programs (applets)" (col 3, lines 55-63).
>
> At they time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Ohta and Broulik before him or her, to create a GUI that presents steps with a GUI that is web applicable with a language like Java.
>
> The motivation for doing so would have been to allow a GUI that presents steps that could be accessed remotely by multiple users via web.

Ohta and Broulik do not appear to explicitly disclose *a method using a Java Server Page.*

However, Hind discloses *a method presenting a Java Server Page.*

- Hind discloses that "using Java Server Pages to enable transcoding the content of a document requested by a client, in order to tailor the output document according to application-specific characteristics." (abstract).

- The examiner notes that Hind uses Java Server Pages for client-server oriented tasks and Java is used to program web pages.

Ohta, Broulik, and Hind are both analogous art because they are from the same field of endeavor of graphical user interface applications.

At they time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Ohta, Broulik, and Hind before him or her, to modify the GUI that identifies a current step within the series of steps to include communication with a client and server because it allows tasks to be listed and oriented in a network system with an universal web based language like Java. Since a Java Server Page is a derivation of Java, it would also be obvious to one of ordinary skill to create a response that is with Java as taught by Broulik in combination with a Java Server Page as taught by Hind

The motivation for doing so would have been to allow an user interface with inline representation of steps in a multi-stepped process in conjunction with a network system in order to allow an user to see a series of steps in a task on a internet system with a Java Server Page (see abstract).

Therefore, it would have been obvious to combine Hind with Broulik and Ohta to obtain the invention as specified in the instant claim.

Office action of May 10, 2007, pp. 13-14.

IV.B.1. The Proposed Combination of References, Considered as a Whole, Does Not Teach or Suggest all of the Claimed Features

Claim 5 as amended is as follows:

> 5.   The method of claim 2, wherein presenting the current step inline within the series of steps includes generating a response page using a JAVA Server Page.

The examiner failed to state a *prima facie* obviousness rejection against claim 5 because the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1, from which claim 5 depends. As shown above, *Ohta* does not teach all of the features of claim 1. Furthermore, *Ohta* does not suggest the claimed feature because *Ohta* is devoid of disclosure regarding the features of claim 1. Additionally, *Ohta* does not suggest the features of claim 1 because *Ohta* is not

concerned with identifying substeps within steps because *Ohta* is only concerned with showing all of the steps of a generated flowchart.

Additionally, *Broulik* does not teach or suggest all of the features of claim 1. *Broulik* teaches a web based graphical user interface server and method for a telecommunications node that provides craft user interface capability with regard to remote login. *Broulik*, Abstract. *Broulik* is completely devoid of disclosure regarding the features of claim 1.

Additionally, *Hind* does not teach or suggest all of the features of claim 1. *Hind* teaches a method for using Java Server Pages to enable transcoding of the content of a document requested by a client in order to tailor the output document according to application-specific characteristics. *Hind*, Abstract. *Hind* is completely devoid of disclosure regarding the features of claim 1.

Therefore, none of *Ohta*, *Broulik*, or *Hind* teach or suggest all of the features of claim 1. Accordingly, the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1. Hence, under the standards of *In re Royka*, the examiner failed to state a *prima facie* obviousness rejection against claim 1.

At least by virtue of the dependency of claim 5 on claim 1, the examiner failed to state a *prima facie* obviousness rejection against claim 5. For similar reasons, the examiner failed to state a *prima facie* obviousness rejection against claims 6, 8-10, 15-16, 18-21, and 23.

IV.B.2. The Examiner Failed To State a Proper Reason To Combine the References Under the Standards of *KSR Int'l.*

Additionally, the examiner failed to state a *prima facie* obviousness rejection against claim 5 because the examiner failed to state a proper reason to combine the references under the standards of *KSR Int'l*. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Regarding a reason to combine the references, the examiner states that, "the motivation for doing so would have been to allow an user interface with inline representation of steps in a multi-stepped process in conjunction with a network system in order to allow an user to see a series of steps in a task on a internet system with a Java Server Page (see abstract)." However, this reason is not a rational underpinning to support the legal conclusion of obviousness of claim 5 in view of the combination of the references considered as a whole. As a first matter, as shown above, *Ohta* does not teach a user interface with inline representation of substeps in a multi-stepped process. As a second matter, *Broulik* is directed towards remote login though telecommunications systems via a graphical user interface, not displaying

steps within a process. As a third matter, *Hind* is directed towards remote login to a graphical user interface server, not displaying steps within a process. As a fourth matter, access to an application is irrelevant to the invention of claim 5. Instead, the invention of claim 5 leaves the matter of access silent and is only concerned with how to present the steps of the process.

Whether access is granted and to how many users access is granted is irrelevant to the invention of claim 5. Therefore, the examiner's statement does not provide a rational underpinning to support the legal conclusion of obviousness, as required by *KSR Int'l*. Accordingly, under standards of *KSR Int'l*., the examiner failed to state a *prima facie* obviousness rejection against claim 5. For similar reasons, the examiner failed to state a *prima facie* obviousness rejection against claims 6, 8-10, 15-16, 18-21, and 23.

IV.B.3. No Reason Exists To Combine the References Under the Standards of *KSR Int'l.*

Additionally, no rational reason exists to combine the references to achieve the invention of claim 5 when the references are considered as a whole. *Ohta* is directed to the creation of code from a flowchart. *Broulik* is directed to remote login systems via a graphical user interface. *Hind* is directed towards remote login to a graphical user interface server. The three references have nothing to do with *Ohta*, the primary reference, other than the three references require the use of a computer to perform the disclosed methods.

Because the references have nothing to do with each other or the primary reference, and because the references have nothing to do with claim 5, one of ordinary skill could find no reason to combine the references to achieve the invention of claim 5, when the references are considered together as a whole. Accordingly, under the standards of *KSR Int'l*., the examiner failed to state a *prima facie* obviousness rejection against claim 5. For similar reasons, the examiner failed to state a *prima facie* obviousness rejection against claims 6, 8-10, 15-16, 18-21, and 23.

IV.B.4. *Hind* Is Non-Analogous Art.

The examiner has failed to state a *prima facie* obviousness rejection because *Hind* is non-analogous art. In order to rely on a reference as a basis for rejection, the reference must be either in the applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986).

In the case at hand, *Hind* is not in the same field of endeavor of Claim 5 and *Hind* is not reasonably pertinent to the particular problem with which Applicants were concerned. With regard to the first part of the test for analogous art, *Hind* is not in the same field of endeavor of Claim 5 because *Hind* is in the field of remote login to a graphical user interface server. In contrast, Claim 5 is in the field of

presenting methods to users. The two fields are completely distinct from each other because the methods and techniques taught by the two references are completely distinct from each other. Thus, *Hind* fails the first test of *In re Oetiker.*

With regard to the second part of the test for analogous art, *Hind* is not reasonably pertinent to the particular problem with which Applicants were concerned. As established above, *Hind* is in the field of remote login to a graphical user interface server. Specifically, *Hind* is directed to the problem of providing Java server pages in transcoding environments. For example, *Hind* provides that:

> In view of the advantageous aspects of using JSPs as discussed above, it would be desirable to incorporate JSPs in transcoding environments. There is currently no known technique for providing this capability. Accordingly, what is needed is a technique with which a JSP author can specify application-specific characteristics to be used in the transcoding process, enabling the transcoding engine to generate output that is more precisely tailored for the requesting user.

Hind, col. 3, ll. 39-47.

In contrast, Claim 5 is directed to the problem of presenting methods to users. The problem addressed by *Hind* is completely distinct from the problem addressed by Claim 5. For this reason, *Hind* is not reasonably pertinent to the particular problem with which Applicants were concerned. Therefore, *Hind* fails the second part of the *In re Oetiker* test for analogous art.

Nevertheless, the examiner states that:

> Ohta, Broulik, and Hind are both analogous art because they are from the same field of endeavor of graphical user interface applications.

Office action of May 10, 2007, p.8

The examiner appears to confuse the concept of non-analogous art. The question is not whether *Ohta, Broulik,* and *Hind* are analogous to each other, but rather whether *Ohta, Broulik,* and *Hind* are analogous *to claim 5*. As shown below, *Hind* is not analogous to claim 5.

In light of the requirements of *In re Oetiker* the examiner's characterizations of *Hind* and Claim 5 are too broad to establish that *Hind* is in the same field of endeavor as Claim 5. For example, the court in *In re Oetiker* stated that:

> The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art.

In re Oetiker, 977 F.2d 1443 at 1446.

The examiner in *In re Oetiker* attempted to use substantially the same argument as the present examiner. The argument is as follows: Because the reference and the claim both deal with the same broad class of problem, the reference is in the same field of endeavor as the claimed invention. However, the

Court of Appeal for the Federal Circuit specifically states that this argument is incorrect:

> *It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.* The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of *Hind*sight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

Id. at 1447 (emphasis supplied).

The court ruled that the examiner failed to show that a person of ordinary skill solving a problem of fastening *hose clamps* would reasonably be expected or motivated to look to a reference dealing with *fasteners for garments*. Even though both technologies are in the same broad field of fastening objects, the reference was still considered to be non-analogous art.

In the case at hand, *Hind* is directed to the field of remote login to a graphical user interface server. In contrast, Claim 5 is directed to the field of presenting methods to users. These fields are more distinct from each other than the field of hose clamps and the field of fasteners for garments. In fact, the fields of hose clamps and fasteners for garments are *more* closely related because both are fasteners. In stark contrast, the invention of Claim 5 is more divergent from the field of *Hind*. Therefore, under the standards of *In re Oetiker*, *Hind* is non-analogous art to Claim 5, notwithstanding the examiner's assertions to the contrary. Accordingly, the examiner failed to state a *prima facie* obviousness rejection against Claim 5.

The rejections of claims 6, 8-10, 15-16, 18-21, and 23 all rely on the combination of *Ohta* and *Hind*. Therefore, because *Hind* is non-analogous art, the examiner also failed to state a *prima facie* obviousness rejection against these claim. Accordingly, this rejection is overcome.

IV.C.   Claims 7, 17, and 22

The examiner rejects claims 7, 17, and 22 under 35 U.S.C. § 103 as obvious in view of *Ohta*, *Broulik*, *Hind*, and *Scheinblum*, J., Make Your Applications Strut, builder.com.com/5100-6386-1027640.htm, March 2002 (hereinafter "*Scheinblum*"). This rejection is respectfully traversed.

Scheinblum could not be retrieved from the Web address cited by the examiner. However, Applicants found what appears to be the same article at articles.techrepublic.com.com/5100-22-1027640.html. Applicants assume that the article obtained at this addressed is the article intended to be cited by the examiner.

Regarding claim 7, the examiner states that:

> Ohta, Broulik, and Hind teach the invention as mentioned above.

Ohta, Broulik, and Hind does not discloses explicitly disclose *a method wherein building the response page using a Struts framework.*

However, Schein' discloses *a method presenting a Struts Framework.*

- Schein' states that "the Struts Framework is a Java-based technology that allows Web application developers to take advantage of object-oriented design, reusable code, and "write once, run anywhere" functionality. Struts provides a framework for creating Web applications that abstracts the backend code of your applications from the display, or presentation, of your data" (1st paragraph).

- The examiner notes that Struts, which is based on Java technology, can be used on any web application, including response pages that are web-based.

Ohta, Broulik, Hind, and Schein' are analogous art because they are from the same field of endeavor of graphical user interface applications.

At they time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Ohta, Broulik, Hind, and Schein' before him or her, to modify the GUI that identifies a current step within the series of steps to include communication with a client and server with Tiles and Struts because it allows tasks to be listed and oriented in a GUI with rectangular windows-like fashion in a network system with an universal web based language like Java.

The motivation for doing so would have been to allow an user interface with inline). representation of steps in a multi-stepped process in conjunction with a network system in order to allow an user to see a series of steps in a task on a internet system with a Java Server Page (see abstract) and also allow a frame work for the-webpage using Struts.

Therefore, it would have been obvious to combine Schein with Ohta, Broulik, and Hind to obtain the invention as specified in the instant claim

Office action of May 10, 2007, pp. 25-26.

The Proposed Combination of References, Considered as a Whole, Does Not Teach or Suggest all of the Claimed Features

Claim 7 as amended is as follows:

7.   The method of claim 5, wherein generating a response page includes building the response page using a Struts framework.

The examiner failed to state a *prima facie* obviousness rejection against claim 7 because the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1, from which claim 7 depends. As shown above, *Ohta* does not teach all of the features of claim 1.

Furthermore, *Ohta* does not suggest the claimed feature because *Ohta* is devoid of disclosure regarding the features of claim 1. Additionally, *Ohta* does not suggest the features of claim 1 because *Ohta* is not concerned with identifying substeps within steps because *Ohta* is only concerned with showing all of the steps of a generated flowchart.

Additionally, *Broulik* does not teach or suggest all of the features of claim 1. *Broulik* teaches a web based graphical user interface server and method for a telecommunications node that provides craft user interface capability with regard to remote login. *Broulik*, Abstract. *Broulik* is completely devoid of disclosure regarding the features of claim 1.

Additionally, *Hind* does not teach or suggest all of the features of claim 1. *Hind* teaches a method for using Java Server Pages to enable transcoding of the content of a document requested by a client in order to tailor the output document according to application-specific characteristics. *Hind*, Abstract. *Hind* is completely devoid of disclosure regarding the features of claim 1.

Additionally, *Scheinblum* does not teach or suggest all of the features of claim 1. *Scheinblum* teaches how to create Java-based struts frameworks. *Scheinblum*, paragraph 1. *Scheinblum* is completely devoid of disclosure regarding the features of claim 1.

Therefore, none of *Ohta*, *Broulik*, *Hind*, or *Scheinblum* teach or suggest all of the features of claim 1. Accordingly, the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1. Hence, under the standards of *In re Royka*, the examiner failed to state a *prima facie* obviousness rejection against claim 1.

At least by virtue of the dependency of claim 7 on claim 1, the examiner failed to state a *prima facie* obviousness rejection against claim 7. For similar reasons, the examiner failed to state a *prima facie* obviousness rejection against claims 17 and 22.

V. __Conclusion__

The subject application is patentable over the cited references and should now be in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 10, 2007

Respectfully submitted,

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